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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/521,376   | 01/18/2005  | Christian Herzig     | WAS0675PUSA         | 2144             |
| 22045  | 7590        | 09/20/2006           | EXAMINER            |                  |
| BROOKS KUSHMAN P.C.<br>1000 TOWN CENTER<br>TWENTY-SECOND FLOOR<br>SOUTHFIELD, MI 48075 |             |                      | ZIMMER, MARC S      |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 1712                |                  |

DATE MAILED: 09/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/521,376             | HERZIG ET AL.       |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Marc S. Zimmer         | 1712                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 January 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-22 is/are rejected.
- 7) ☒ Claim(s) 12-22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>07/22/05</u> .  | 6) <input type="checkbox"/> Other: _____                          |

***Election/Restrictions***

This application contains claims directed to numerous permutations of an organosilicon compound bearing silicon-bonded hydrogen groups. The species are independent or distinct because they contain different types of repeating structural attributes and, therefore, the recitation of one species does not even necessarily render obvious another species.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 12 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

During a telephone conversation with William Conger on September 12, 2006 a provisional election was made WITH traverse to prosecute that embodiment of the invention wherein the organosilicon compound (2) contains units of type II and type III,.

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Affirmation of this election must be made by applicant in replying to this Office action. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicant is advised that the Examiner will make of record in this Office action references that teach a related embodiment featuring an unelected embodiment of the claimed invention. This is being done only because these references also represent a foundation for a non-statutory-type double patenting rejection. The election of species requirement has not been withdrawn as the Examiner's search was confined largely to finding only those references that disclose the elected embodiment.

### ***Claim Objections***

Claims 12-22 are objected to because the siloxane additive is characterized in claim 12 as being one having "branched alkenyl groups" however this is not the case. Indeed, the precursors from which the antimisting additive is made themselves do not contain branched alkenyl groups. Rather, the entire product/polymer is branched, not its alkenyl substituents. Correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant is advised that, in view of the awkward language employed, the only affirmative step recited in claim 12 is that of selecting a polymer having specified structural attributes. It is believed, however, that it is not Applicant's intent to claim a process wherein a polymer is merely selected, there being no other manipulations carried out. Rather, it is implicit but not expressly disclosed that the polymer is to be added to a combination of other materials denoted as a crosslinkable silicone composition. This same issue has been raised in at least two counterpart applications and it is recommended that Applicant pursue the same resolution as was enacted in Application Serial No. 10/506657.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 12-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Clark et al., U.S. patent # 6,586,535. Clark teaches silicone coating compositions to which are added equivalent mist suppressant compositions. The coating composition is one that is addition cured, the essential ingredients of which are disclosed in column 3, line 7 to column 6, line 32. The mist-suppressing additive is a product derived from the reaction of a polysiloxane bearing at least three alkenyl groups with an organohydrogensiloxane bearing at least two hydrosilyl groups in the presence of a platinum catalyst. The organosilicon compounds are furnished in quantities that provide at least 4.6 alkenyl groups for every hydrosilyl group present (column 8, lines 50-64 and column 10, lines 50-65). These materials are exemplified in the teachings at column 9, lines 10-30 and column 10, lines 11-49.

As an aside, it is appreciated that Clark is a U.S. counterpart of WO 01/98420, which is mentioned in the background section of the instant Specification. However, there does not appear to be any patentable distinction between what is recited by the claims and that which is contemplated by the reference. For instance, Applicant asserts that the vinyl-functional polysiloxanes used by Clark in the preparation of their mist suppressants have relatively high functionality and, hence, are hard to prepare but the Examples teach an analogous alkenyl-functional polysiloxane with a degree of polymerization of about 150 and 2 mol% vinyl incorporation (3 vinyl groups per molecule). Further, Applicant's claims do not forbid the utilization of polysiloxanes having higher vinyl content.

Claims 12-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Herzig et al., U.S. Patent Nos. 6,764,717 and 6,956,09, the two of which have identical disclosures. These references teach coating compositions identical to those contemplated by the claims and antimisting additives that are equivalent to that embodiment of claimed component (2) having units II, V, and VI.

***Claim Rejections - 35 USC § 102/103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12-15 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Inokuchi et al., U.S. Patent # 5,527,841. They describe organopolysiloxane-based coating compositions comprising the materials (a) through (c) outlined in the abstract and also cured silicone rubber particles (d). The materials involved in the preparation of component (d) are those described in column 6, line 51 through column 9, line 50. Relevant to the present

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discussion, it is stated in column 8, lines 45-51 that the ratio of alkenyl groups to silicon-bonded hydrogen atoms is 1:0.5 to 1:20. Of course, where the ratio is greater than 1:1, the claimed invention is anticipated. At the very least, an embodiment wherein the particles contain residual alkenyl groups is obvious as the required ratio is certainly taught with sufficient specificity.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 12-24 rejected on the ground of nonstatutory double patenting over claims 1-11 of U. S. Patent No. 6,764,717 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.



The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter. There is overlap between the subject matter of the instant claims and those of the patent where component (2) of instant claim 12 contains units of the type II, V, and VI. That the instant claims do not recite the process steps involved with making component (2) is immaterial inasmuch as, in the absence of any such recitation, any reasonable synthetic approach is embraced.

Claims 12-24 are rejected on the ground of nonstatutory double patenting over claims 1-11 of U. S. Patent No. 6,956,096 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent. The presently claimed process employs precisely the same composition as is claimed where (2) contains units of types II, V, and VI. Further, that the composition disclosed in the patent is to be coated onto substrates is implicit in the fact that it contains an antimisting additive.

Yamamoto et al., U.S. Patent Application Publication No. 2004/0127636 is cited as being of interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.

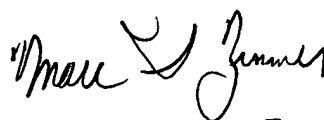
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

September 13, 2006

  
**MARC S. ZIMMER**  
**PRIMARY EXAMINER**